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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,094

12/21/2005

Kazuo Hayashi

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EXAMINER

DESAI, ANISH P

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

09/09/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com
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Office Action Summary	Application No.	Applicant(s)	
	10/562,094	HAYASHI ET AL.	
	Examiner	Art Unit	
	ANISH DESAI	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/11/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected for the following reasons:
2. The left figure of Figure 2 (submitted on 12/21/05) is marked with numerals 27-28-29-30. However, based on the description of Figure 2 in the specification (see Example 1) it appears that the aforementioned numerals in the left figure of Figure 2 should also be labeled as 21-22-23-24.
3. If Applicant agrees with the Examiner then corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites "and a ratio of the areas of the two regions is changed at least in one direction". It is not clear as to what is meant by ratio is changed. Does it mean that the ratio is increased or decreased? Alternatively, does it mean that there are more opaque regions than transparent regions or that there are less opaque regions than the transparent regions? For the purpose of the examination, said recitation is interpreted as the ratio of the opaque region to the transparent region is either increased or decreased, and if prior art discloses a decorative sheet having same structure and composition as claimed by claim 1, then it will meet said recitation.

Claim Rejections - 35 USC § 102 or 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kentaro (JP2002-002192-English translation provided by the Examiner).

7. Kentaro teaches a decorative film (equated to Applicant's shading decorative sheet) useful for the interiors of automobiles and buildings (0001, page 4). The decorative film of Kentaro comprises a base layer having a design pattern formed on at least one surface of the base layer wherein the design pattern comprises a plurality of design elements in which at least 50% of the regions have a certain gradation in one or more directions (0004, page 5). Additionally, Kentaro teaches that an adhesive layer can be formed on the decorative layer or on the base sheet.

8. The aforementioned disclosure of Kentaro is interpreted that a shading decorative sheet having a structure of a decorative layer having a gradation pattern at least in one direction/base layer/adhesive layer is contemplated by Kentaro. Moreover, as a base layer, Kentaro discloses the base layer formed of polyvinyl chloride resin, polypropylene resin, polyethylene resin etc. (0026, page 9). It is noted that Applicant's base layer is generally formed of the same material as that of taught by Kentaro (see 0019 of US Patent Application Publication 2007/0116949A1 of the presently claimed invention). Therefore, the base layer of Kentaro is equated to the transparent base layer of the claimed invention.

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9. As to the claimed features of "gradation pattern comprising an opaque region having a haze of at least...ratio of the...in one direction" (claim 1), "gradation pattern comprises a part consisting of opaque...transparent region" (claim 2), "gradation pattern comprises a part...the transparent region", (claim 3) "gradation pattern comprises a part...the transparent region" (claim 4), "gradation pattern comprises a part...plurality of discrete opaque regions" (claim 5), "gradation pattern comprises a part...the transparent region" (claim 6), "gradation pattern comprises a part...discrete opaque regions", and "wherein a boundary between...in an area of..cm" (claim 8), it is reasonable to presume that said features are present in the invention of Kentaro. The support for said presumption is based on the facts that the shading decorative sheets of Kentaro and Applicant comprise a transparent base layer having a decorative layer provided on one surface of the transparent base layer, wherein the decorative layer has a gradation pattern at least in one direction, and a layer of adhesive is provided on the other surface of the base layer. Therefore, the shading decorative sheet of Kentaro is structurally and compositionally equivalent to Applicant's claimed shading decorative sheet. Thus, the aforementioned features would be present. The burden is shifted to Applicant to prove it otherwise (see *In re Fitzgerald*, 205 USPQ 594). In addition, the presently claimed properties would obviously have been present once the shading decorative sheet of Kentaro is provided (see *In re Best*, 195 USPQ at 433, footnote 4 CCPA 1977).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./
Examiner, Art Unit 1794

/Hai Vo/
Primary Examiner, Art Unit 1794